

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as “Species I”, deemed drawn to the filter of Fig. 5 in the present application, and corresponding to claims 25-30 and 34-45.

REMARKS

In response to Applicant’s election to the last Restriction Requirement, the Examiner has now alleged four ‘species’ and has required election thereof. The Examiner’s classification of the ‘species’ include: Fig. 5, directed to a perspective view of one embodiment of a dynamic filter in accordance with the present invention; Fig. 6, directed to a perspective view of another embodiment of a dynamic filter in accordance with the present invention; Fig. 7, directed to a perspective view of another embodiment of a dynamic filter in accordance with the present invention; and Fig. 8, directed to a perspective view of another embodiment of a dynamic filter in accordance with the present invention.

To begin, Applicant wishes to address the finality of the restriction imposed between Invention I and Inventions II and III. *See Restriction Requirement*, November 27, 2007, p. 2-3. In maintaining the restriction, the Examiner set forth incoherent assertions found on page 2 of the present Restriction Requirement. *See id.* at 2. Applicant finds the text set forth on page 2 to be extremely unclear, and respectfully requests that the Examiner provide at least a coherent explanation for maintaining restriction in the next Office Action. Providing a more reasoned restriction would expedite the prosecution of this application, as the Examiner has indicated as being desirable.

To aid in expediting prosecution of the present application, Applicant presents herein what is believed to be a more accurate restriction of the present claims. That is, Applicant suggests that a more appropriate restriction of the present claims would identify a first invention (I) directed to a system and method for filtering radiation having a filter with a variable attenuation profile, a second invention (II) directed to a system and method for filtering radiation having first and second translatable variable attenuation filters, and a third invention (III) directed to a system and method for calibrating variable attenuation filters to avoid image artifacts. Applicant believes that suggested Invention I corresponds to claims 1-14, 25-35, and 41-48; suggested Invention II corresponds to claims 15-20 and 36-40; and suggested Invention III corresponds to claims 21-24. Applicant respectfully requests that the Examiner consider the suggested restriction set forth above and if agreeable, Applicant elects suggested Invention I.

In the event the Examiner maintains the present identification of “inventions” as in the current restriction, Applicant requests consideration of the comments set forth below. Applicant believes that the final restriction imposed between Invention I and Inventions II and III is improper. The Examiner has failed to show, for example, how claims 1 and 14 (Invention I) are “unconnected in design, operation, and effect” from claims 25 and 26 (Invention II). The Examiner has still, despite Applicant’s previous arguments, failed to provide how Invention I is unconnected in design, operation, and effect from Inventions II and III, other than to assert that Invention I is directed to a method and Inventions II and III are directed to a radiation emitting system and a computer readable storage medium, respectively. As mentioned above, the arguments presently set forth by the Examiner to this effect are extremely unclear and, at best, appear to only address the preamble of the claims. As such, Applicant believes the continued restriction between Invention I and Inventions II and III is improper.

In regards to the substance of the presently imposed species restriction, Applicant believes that the Examiner has failed to meet the requirements set forth in the MPEP for imposing a species restriction. In imposing the species restriction, the entirety of the Examiner’s analysis consisted of the statement that “[t]he species are independent or distinct because the applicant expressly states on pages 5 and 6 of the specifications that Fig. 5 is a perspective view of one embodiment of a dynamic filter in accordance with the present invention, Fig. 6 is a perspective view of another embodiment...” and that Figs. 7 and 8 are additional embodiments of the dynamic filter of the present invention. *See Restriction Requirement*, supra at 3. No other bases for restriction between the identified species were provided by the Examiner.

The MPEP states that “species may be either independent or related under the particular disclosure.” *MPEP §806.04(b)*. In either case, a burden is placed on the Examiner to show that the species are in fact either independent, or related as disclosed and distinct as claimed. If the Examiner claims that the species are independent inventions, he must show that they “**are not connected in any of design, operation or effect under the disclosure.**” *Id.* Alternatively, where there is a relationship disclosed between distinct species, “**then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions** such as those covered in MPEP §806.05 - §806.05(j).” *Id.* In imposing the restriction, the Examiner failed to satisfy either burden. That is, the Examiner failed to either show (1) that the species were not connected in design, operation, or effect, or alternatively, (2) that the restriction was proper under both the practice applicable to

election of species and the practice applicable to other types of restrictions. As the Examiner has failed to satisfy this burden under MPEP §806.04(b), the restriction is improper.

Also, as stated in MPEP §803, “Examiners must provide reasons and/or examples to support conclusions... to support the restriction requirement.” As set forth above, the entirety of the Examiner’s reasons for restriction consists in pointing out Applicant’s use of the word “embodiment,” somehow suggesting that the use of the word “embodiment” necessarily equates to separate species. There is no support in the MPEP, the CFR, statutes, or case law for such a position. Clearly, the use of “embodiment” and the description of various embodiments cannot be a proper basis for a species restriction.

The Examiner has also alleged that no generic claim exists. *See Restriction Requirement*, supra at 4. However, each of independent claims 25, 36, and 41 is indeed generic to each of the alleged species. That is, each of claims 25, 36, and 41 calls for a filter having a variable attenuation profile that is generic across the plurality of the alleged “species” corresponding to Figs. 5-8. Each of these claims reads on all of the figures associated with the alleged species. Accordingly, as each independent claim is generic, Applicant requests joinder of all of claims 25-48 of the present application.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. Alternatively, to avoid the need for a Request for Supervisory Review of both of the previous Restriction Requirements, and expedite prosecution, Applicant proposes a more proper Restriction Requirement herein. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,

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